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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,872	07/24/2001	Yasumichi Kuwayama	Q65548	4044

7590 12/06/2004

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EXAMINER
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GUSHI, ROSS N

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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DEC 06 2004

GROUP 2800

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/910,872  
Filing Date: July 24, 2001  
Appellant(s): KUWAYAMA ET AL.

GROUP 2800  
DEC 06 2004  
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Terrance Wikberg  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/4/04.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

4561714	Byczek et al.	12-85
4371225	Narozny	2-83

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6, 7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byczek et al. ("Byczek") in view of Narozny.

Regarding claim 1, Byczek discloses a terminal 12 connected to a flat circuit 10 comprising a plane portion, a pair of piercing portions (32) erected from opposite side edges of the plane portion which penetrate through a coating and a conductor (col. 3, lines 10-15) of the flat circuit body and tips thereof are folded in such a direction as to approach each other, wherein the piercing portions include a root portion and a distal portion. Byczek does not discuss whether the distal portion is inclined with respect to an internal surface of the root portion so that the distal portion is tapered.

Narozny discloses a terminal 16 connected to a flat circuit 10 comprising a plane portion (at 50), a pair of piercing portions (46, 48) erected from opposite side edges of the plane portion, wherein the piercing portions include a root portion and a distal portion, where an internal surface (46a, 48a) of the distal portion is inclined with respect to an internal surface of the root portion so that the distal portion is tapered.

At the time of the invention, it would have been obvious to taper the inner or outer surfaces of the Byczek teeth (or both inner and outer surfaces) as desired as taught by Narozny. The suggestion or motivation for doing so would have been to control the degree of to which the teeth would be directed inwardly or outwardly during assembly with the flat circuit, as taught in Narozny (col. 3, lines 40-59).

Regarding claim 2, as noted regarding claim 1, at the time of the invention, it would have been obvious to taper either or both the inner and outer surfaces for the reasons noted regarding claim 1.

Per claims 4, 6, 7, 9, and 10 Byczek discloses that the first portions have a constant width in the longitudinal direction.

**(11) Response to Argument**

Applicant argues that there is to motivation to combine the references. (Brief pages 15-18). The examiner maintains that Narozny explicitly details the motivation for modifying the teeth. Narozny teaches that the suggestion or motivation for tapering the teeth would have been to control the degree of to which the teeth would be directed inwardly or outwardly during assembly with the flat circuit (col. 3, lines 40-59).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight (Brief pages 15-18) reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made,

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and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues that Narozny projections 46 and 48 do not pierce the conductor (brief page 17). Narozny is relied on by the examiner for the teaching that the tapering of the inner and outer surfaces is useful for directing the teeth inwardly and outwardly as desired, whether through the conductor or not. Narozny teaches that one would have tapered the inner and outer surfaces as desired to control the deflection direction of the teeth as they passed through the cable, whether through the conductor or not. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

November 16, 2004

Conferees

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Ross Gushi

**ROSS GUSHI**  
**PRIMARY EXAMINER**



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